

ESTTA Tracking number: **ESTTA653588**

Filing date: **02/02/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Brookshire Brothers, Inc.		
Entity	Corporation	Citizenship	Texas
Address	1201 Ellen Trout Drive Lufkin, TX 75904 UNITED STATES		

Attorney information	J. Daniel Harkins Cox Smith Matthews Incorporated 112 East Pecan Street, Suite 1800 SAN ANTONIO, TX 78205 UNITED STATES ipdocket@coxsmith.com Phone:(210) 554-5285
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Applicant Information

Application No	86199663	Publication date	01/13/2015
Opposition Filing Date	02/02/2015	Opposition Period Ends	02/12/2015
Applicant	Brookshire Grocery Company 1600 W. Southwest Loop 323 Tyler, TX 75701 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2009/07/08 First Use In Commerce: 2009/07/08
All goods and services in the class are opposed, namely: retail grocery store services; retail pharmacy services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Fraud - 18 U.S.C. Â§ 1001

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BROOKSHIRE BROTHERS		
Goods/Services	Retail grocery store services, pharmacy services, and other related goods and services.		

Attachments	Notice of Opposition 86199663.pdf(1407182 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/jdanielharkins/
Name	J. Daniel Harkins
Date	02/02/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application
Serial No. 86/199,663

Published in the Official Gazette
(Trademarks) on January 13, 2015

For the Mark: BROOKSHIRE'S FOOD & PHARMACY (AND DESIGN)

BROOKSHIRE BROTHERS, INC.,	§	
a Texas corporation	§	
Opposer	§	
	§	
v.	§	Opposition No. _____
	§	
BROOKSHIRE GROCERY COMPANY,	§	
a Texas corporation	§	
Registrant	§	

NOTICE OF OPPOSITION

Box TTAB Fee
Commissioner for Trademarks
U.S. Patent and Trademark Office
P.O. Box 1451
Arlington, VA 22313-1451

Dear Sir/Madam:

This Notice of Opposition is brought against pending trademark application Serial No. 86/199,663, filed on February 20, 2014 by Brookshire Grocery Company (hereinafter "Applicant"), for registration of the proposed mark BROOKSHIRE'S FOOD & PHARMACY (AND DESIGN) for services identified as retail grocery store services; retail pharmacy services in International Class 35 (the "Opposed Application").

The Opposed Application was published in the Official Gazette on January 13, 2015. Brookshire Brothers, Inc. (hereinafter "Opposer"), a Texas corporation believes that it will be

damaged by registration of such trademark and hereby opposes the same. Opposer submits this Notice of Opposition within the opposition period.

The grounds for opposition are as follows:

1. Opposer's predecessor-in-interest was a Texas general partnership, trading as Brookshire Brothers, founded in or about 1921, by two brothers, Austin and Tom Brookshire, to carry on a grocery business.

2. Opposer's predecessor-in-interest, the Brookshire Brothers partnership, adopted and began using BROOKSHIRE as a trademark, service mark, and mark formative (the "BROOKSHIRE" mark) in or about 1921 for retail grocery store services as well as for related products and services. Opposer and Opposer's direct-predecessor-in-interest, the Brookshire Brothers partnership, have continuously used the BROOKSHIRE mark since its adoption in at least as early as 1921 in connection with retail grocery store services, and related products and services.

3. After the initial founding of the Brookshire Brothers partnership, other individuals joined the Brookshire Brothers partnership, one of whom was W.T. Brookshire, a brother to Austin and Tom Brookshire.

4. In or about 1929, W.T. Brookshire sold his partnership interest in the Brookshire Brothers partnership back to the partnership in exchange for two (2) retail grocery stores located in Tyler, Texas. W.T. Brookshire renamed the two stores in Tyler "BROOKSHIRE'S GROCERY" and commenced doing business as Brookshire's Grocery, the direct predecessor-in-interest to Registrant, Brookshire Grocery Company.

5. In 1992, Applicant obtained U.S. Service Mark Registration No. 1,672,896 issued on January 21, 1992, for the mark BROOKSHIRE'S for retail grocery store services in International Class 42. That registration was issued under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

6. Upon obtaining knowledge of the '896 Registration, Opposer contacted Applicant to inform them of their objection to the Registration of the BROOKSHIRE'S mark based upon its preexisting rights to the BROOKSHIRE mark and based upon Applicant's fraudulent declaration to the Trademark Office.

7. After negotiations and pursuant to a mutual agreement, Applicant caused to be filed a Voluntary Cancellation and Surrender of Registration on January 21, 1997. The Registration was administratively cancelled on February 2, 1998.

8. Upon information and belief, Opposer and Applicant came to an agreement that neither would seek to register a mark that included the formative BROOKSHIRE or BROOKSHIRE'S.

9. Opposer has operated under its understanding of this agreement and has refrained from filing any trademark or service mark applications that included the formative BROOKSHIRE or BROOKSHIRE'S.

10. In 2004, however, Applicant filed eight (8) applications for marks that included the formative BROOKSHIRE'S.

11. In 2005, upon obtaining knowledge of the applications, Opposer contacted counsel for Applicant and objected to the filing of the applications based upon Opposer's belief that the filings constituted a material breach of the previous agreement between Opposer and Applicant, Opposer's preexisting rights to the BROOKSHIRE mark and the fraudulent claims made by Applicant to the Trademark Office.

12. On January 4, 2006, Applicant filed for Express Abandonment of each of the applications.

13. In the current application for registration, Applicant has declared, under the penalties provided by 18 U.S.C. § 1001, that it is the owner of the BROOKSHIRE'S mark, and that "no other person, firm, corporation, or association has a the right to use the mark in commerce, either in the identical form thereof, or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

14. At the time the representations were made, Applicant knew or should have known that these representations were false. Indeed, principals in both Opposer's company and Applicant's company are part of the same Brookshire family, and the individual signing the Application had actual knowledge of Opposer's use of the BROOKSHIRE mark for the same goods and services.

15. Furthermore, Applicant had actual knowledge of the previous disputes regarding the BROOKSHIRE mark.

16. There currently are, and for some time have been, instances of actual confusion between Opposer's BROOKSHIRE mark and Applicant's BROOKSHIRE'S mark, including but not limited to misdirected vendor payments, mail, lawsuits, customer compliments and complaints as well as confusion by a governmental inspector regarding which site to inspect.

17. In the current Application, Applicant represented under 15 U.S.C. § 1052(f) that Applicant had substantially exclusive and continuous use of the BROOKSHIRE'S mark.

18. Applicant is not (and was not at the time of the filing of this application for registration) the rightful owner of the registered mark. Opposer is the rightful owner of the

BROOKSHIRE mark, and the continued registration of the BROOKSHIRE'S mark will damage Opposer.

19. Opposer has expended considerable time, effort and expense in promoting its BROOKSHIRE mark and the goods and services sold under such mark, with the result that the purchasing public has come to know, rely upon and recognize the high quality of the goods and services that Opposer offers under the BROOKSHIRE mark. Indeed, Opposer has exceedingly valuable goodwill established in this mark.

20. Opposer is the first and senior user of the mark. Opposer's use of the BROOKSHIRE mark, through its direct predecessor-in-interest, long pre-dates Applicant's use of BROOKSHIRE'S mark. Opposer has continuously used the BROOKSHIRE mark and has not abandoned its use thereof.

21. The applied for mark BROOKSHIRE'S so resembles Opposer's marks BROOKSHIRE and BROOKSHIRE BROTHERS, as to be likely to cause confusion, or to cause mistake, or to deceive. Opposer and Applicant both use BROOKSHIRE and BROOKSHIRE'S, respectively, for retail grocery store services, as well as for the same or substantially the same related goods and services. There have been numerous instances of actual confusion between Opposer's and Applicant's marks.

22. Application No. 86/199,663 was fraudulently filed by Applicant. Applicant knew or should have known of Opposer's prior and extensive use of the BROOKSHIRE mark, yet Opposer's prior and extensive use was never disclosed to the U.S. Patent and Trademark Office and, indeed, false and misleading representations were made to the U.S. Patent and Trademark Office concerning Applicant's exclusive right to use the mark.

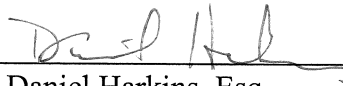
23. Based on the foregoing, Opposer believes that it will be damaged by the registration of the Opposed Application.

WHEREFORE, Opposer respectfully requests that the application for registration of BROOKSHIRE'S FOOD & PHARMACY (AND DESIGN) by Applicant be refused and that this Opposition be sustained.

The required fee of \$300 is submitted herewith. If any additional fees are required, the Commissioner is hereby authorized to charge any such deficiency to Deposit Account No. 03-3483.

Respectfully submitted,
BROOKSHIRE BROTHERS, INC.
a Texas corporation

By its attorneys:
COX SMITH MATTHEWS INCORPORATED



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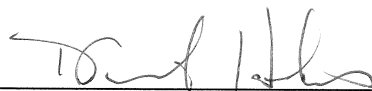
Attorneys for Opposer, Brookshire Brothers, Inc.

Date: Feb. 2, 2015

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition has been sent by first class mail to the following on this the 2nd day of February, 2015.

Elizabeth K. Stanley
Baker Botts L.L.P.
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Dallas, Texas 75201-2900
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A handwritten signature in black ink, appearing to read "J. Daniel Harkins", is written over a horizontal line.

J. Daniel Harkins, Esq.